

Application No. 10/797,995
Amendment Dated March 6, 2006
Reply to Office Action of November 22, 2005

REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed November 22, 2005. A petition and fee for a one month extension of time is attached. Any additional fees in connection with this Amendment should be charged to our Deposit Account No. 19-3320.

In that Office Action, the Examiner rejected claims 13 and 14 under 35 U.S.C. §112, first paragraph, for lack of support in the disclosure, and rejected claims 11 and 12 under 35 U.S.C. §103(a) as having been "obvious" over U.S. Patent No. 5,882,776 (*Bambara*) in view of U.S. Patent No. 6,221,451 (*Lauer*).

Applicant has cancelled claim 14 without prejudice. This application now contains a total of three claims. Of these, claim 11 and claim 13 are presented in independent form. Claim 12 is dependent on independent claim 11 and is to be construed as incorporating all the limitations of independent claim 11. If claim 11 distinguishes patentably from the prior art and is allowable, then claim 12 must so distinguish and be allowable. 35 U.S.C. §112. Consequently, with respect to the rejection under 35 U.S.C. §103, the following remarks will focus on the reasons why the cited references do not teach or suggest the combination of features set forth in claim 11.

Rejection Under 35 U.S.C. §112

The Examiner rejected claims 13 and 14 under 35 U.S.C. §112, first paragraph. The Examiner's specific grounds for rejection are that:

The invention as now claimed fails to find support in the disclosure as originally filed. Specifically, there is no basis to claim a core construed of multiple core layers having different densities. The specification sets forth usage of but a single core layer 16 or 43. The claiming of core density between about 4 and 10 lb/ft³ finds no support in the specification as originally filed as well.

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It is respectfully submitted that the Examiner's rejection is focused on claim 14, not claim 13. The Examiner first states that there is no basis for claiming a core construction of multiple core layers having different densities. Claim 13 does not include a limitation that the core layers have different densities. Claim 13 only includes the limitation that the core comprise a first core layer and a second core layer. In this regard, the specification expressly states it is contemplated that the foam core may be formed from two layers laminated together to form the foam core. (Specification, page 4, line 31 - page 5, line 2). Thus, if the rejection is based on lack of support for a core comprised of multiple core layers, the specification clearly supports such a limitation and the rejection would be improper. *See* MPEP 2163.04.

Next, the Examiner objects to the limitation that the core density is between about 4 and 10 lb/ft³ as finding no support in the specification as originally filed. Again, this limitation is found in claim 14, not claim 13. Claim 13 simply refers to a density range of about 1.9 to 4 lb/ft³. The density range of about 1.9 to 4 lb/ft³ is supported by the examples disclosed. (Specification, page 4, lines 30-31 and page 6, lines 9-10). Thus, it is respectfully submitted that the specification fully supports the limitations in claim 13.

Given the requirement that the Examiner must set forth express findings of fact which support the lack of written description conclusion (MPEP 2163), it appears that the Examiner rejected claim 13 based only on the limitations found in claim 14. Rather than claim 13, it is claim 14 that includes the limitations regarding the core layers having different densities and the core including a layer with a density in the range of 4 to 10 lb/ft³ identified by the Examiner in his express findings as lacking support. However, claim 14 has now been cancelled.

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Accordingly, Applicant respectfully requests reconsideration of claim 13 under 35 U.S.C. §112, first paragraph.

Rejection Under 35 U.S.C. §103(a)

The Examiner rejected claims 11-12 under 35 U.S.C. §103(a) as having been “obvious” over *Bambara* in view *Lauer*. To establish “obviousness”: (1) the prior art itself must suggest or motivate the modification of a reference, (2) there must be a reasonable expectation of success, and (3) the prior art must teach or suggest all of the claimed limitations. M.P.E.P. § 2143. In this case, *Bambara* and *Lauer* do not teach or suggest, even when combined, all of the limitations of claim 11. It is respectfully submitted that there is no teaching or suggestion in either *Bambara* or *Lauer* for providing a foam core, a first film layer and an intermediate metallocene-based layer between the foam core and the film layer. In particular, *Bambara* discloses, in Fig. 3, a laminate having an inner core (4), an outer layer (22) and an intermediate layer (24) between the outer layer and the core. However, all of the layers taught by *Bambara* are foam layers. In particular, *Bambara* teaches that:

“Core 4 is a laminated foam with multiple layers. In this embodiment, core 4 has four layers including foam 10, foam 12, foam 16, and foam 18 each have average foam densities of between 1.2 and 2.5 pounds per cubic foot and thicknesses of between 3/8 and 1/2 inches. . . . Skin 6 is a laminated foam including outer foam 22 and inner foam 24. Skin 8 is a laminated foam, including outer foam 26 and inner foam 28. Foams 22, 24, 26, and 28 each have average densities of between 4 and 12 pounds per cubic foot and thicknesses of between 1/16 and 1/8 inches, with the outer foams 22 and 26 having average densities lower than the inner foams 24 and 28.” (Col. 5, lines 41-54) (emphasis added).

In direct contrast, claim 1 as amended calls for a first film layer and an intermediate layer between the first film layer and the core. This is in direct contrast to the teachings of *Bambara*.

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Nor does *Lauer* teach an intermediate metallocene-based polyolefin layer between a first film layer and a foam core. Rather, *Lauer* teaches a foam core 22 and a peripheral layer 24 and indicates that these two layers may be metallocene catalyst polyethylenes. (Col. 14, lines 6-18 and col. 14, lines 47-60). *Lauer* simply provides not teaching of using a metallocene-based layer as a bonding layer between two other layers, let alone a foam layer and a film layer.

Thus, the references relied on by the Examiner, even if combined, fail to teach or suggest all of the claim limitations of amended claim 1. Even combined, these references do not teach a metallocene-based intermediate layer between a foam core and a film layer. If an individual element of a claimed combination is not present, either expressly or implicitly, in any of the references, then the claimed invention would not have been "obvious" from the references. MPEP 2143.03; *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-7 (Fed. Cir. 1983).

In support of the rejection of claims 11-12, the Examiner states: "Furthermore, in this instance, such densities fall within the realm of obvious choice of design, such being well within the layer of skill of the ordinary routiner in the art at the time of the invention, providing no unexpected results. It should be noted in support of this position, no real criticality for such values has been set forth by Applicant." It is respectfully submitted that this statement ignores the fact that throughout the specification the Applicant discusses and highlights the benefits found by using an intermediate metallocene-based polyolefin layer between film and foam layers. For example, the specification states on page 7 beginning at line 3:

Intermediate layers 20, 28, 42 and 44 facilitate the bonding of different polyolefin materials, including as discussed above polyethylene foam and film, polypropylene foam and polyethylene foam, and polypropylene foam and polyethylene film, using conventional thermal laminating process. It is believed that such superior bonding is a result of the intermediate layers having a

lower melt temperature than other materials, low shear viscosity, good winning characteristics, and a linear molecular structure that diffuses quickly and forms a better physical bond with the molecules in the adjacent layers when cooled. Thus, intermediate layers 20, 28, 42 and 44 provide a superior heat laminated bond between the outer layers 23, 31 and 41 and 45 and inner core 16 and 43, respectively.

And in describing the first embodiment, the specification states, in reference to metallocene-based layer 28, that “[t]his intermediate layer provides a superior bond between polyethylene foam and polyethylene film.” (Specification, page 5, lines 4-5). Again, in describing the second embodiment, the specification states that “[i]ntermediate layer 44 facilitates a strong bond between polypropylene foam core 43 and polyethylene film 45.” (Specification, page 6, lines 1-2). Accordingly, throughout the specification the densities of film layers (*e.g.*: p. 4, line 12; p. 4, lines 18-19; p. 5, line 8; p. 6, line 14) and foam layers (*e.g.*: p. 4, line 31; p. 6, line 10) are described and the fact that the intermediate metallocene-based layer provides superior bonding between such layers of differing density is described as one of the advantages.

Furthermore, when obviousness is based on the teachings of multiple prior art references, the Examiner must also establish some “suggestion, teaching, or motivation” that would have lead a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999); *Pro-Mold v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996). It has been consistently held that a person of ordinary skill in the art must not only have some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled

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artist, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” And the relevant art is defined by the nature of the problem confronted by the would be inventor. *Orthopedic Equipment Co. v. U.S.*, 702 F.2d 1005, 1008, 217 USPQ 193, 196 (Fed. Cir. 1983).

In this case, the problem addressed was how to provide a sports board with improved bonding between layers. *Lauer* addresses an entirely different problem, namely how to make a synthetic cork, typically used in wine bottles. This is an entirely different problem to the one faced by the Applicant here. Thus, it is respectfully submitted that the Examiner, having studied Applicant's disclosure, attempted to reconstruct the prior art by selecting references having just "this" feature and just "that" feature. The Examiner is not permitted to the benefit of a careful study of Applicant's disclosure. Rather, his task is to disregard what Applicant has just taught him about the invention, and cast his mind back to the time just prior to the time the invention was made. As noted in *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law.

Because *Bambara* and *Lauer* were facing different problems, it is improper to simply reach into their aggregate disclosures and carefully pull "this" feature from one reference and combine it with "that" feature pulled from the other.

Applicant's attorney respectfully submits that claim 11, and therefore dependent claim 12, would not have been obvious to a person skilled in this art at the time the invention was made.

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Conclusion

This Amendment is believed to be fully responsive to the Office Action of November 22, 2005, is believed to squarely address each and every ground for objection or rejection raised by the Examiner, and is further believed to materially advance the prosecution of this application toward immediate allowance.

Formal allowance of claims 11-13 in light of this Amendment is, therefore, courteously solicited.

Respectfully submitted,

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CERTIFICATE OF MAILING

I certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, this 6th day of March, 2006.

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